



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/319,384	06/04/1999	TAKASHI ECHIGO	Q54629	2943

7590

08/27/2002

SUGHRUE MION ZINN MACPEAK & SEAS
2100 PENNSYLVANIA AVENUE NW
WASHINGTON, DC 200373202

EXAMINER

PRATS, FRANCISCO CHANDLER

ART UNIT	PAPER NUMBER
----------	--------------

1651

DATE MAILED: 08/27/2002

16

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/319,384

Applicant(s)

ECHIGO ET AL.

Examiner

Francisco C Prats

Art Unit

1651

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 13 August 2002 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☒ A Notice of Appeal was filed on 13 August 2002. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☒ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: see attachment.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: see attachment.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: 1-19.

Claim(s) withdrawn from consideration: _____.

8. ☐ The proposed drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____.

Francisco C Prats
Primary Examiner
Art Unit: 1651

ATTACHMENT TO ADVISORY ACTION

The after-final amendment filed January 11, 2001, has been received, but will not be entered because it raises new issues for search and consideration. The text of those sections of Title 35, U.S. Code, not included in this action can be found in a prior office action.

The after-final amendment filed January 11, 2001, raises new issues for search and consideration because the proposed new embodiment has not been searched and/or considered previously. It is noted that claim 1 now recites two limitations, (1) enzyme pH optimum of at least 7.5 and (2) lignosulfonate/lignosulfonic acid substrate, which were originally presented as *separate embodiments* of the claimed invention. However, until now, applicant never presented these two limitations in a single embodiment. Thus, this new embodiment requires new search and consideration, particularly with respect to issues such as motivation for practicing together the two newly joined limitations. Non-entry at this stage of is clearly proper.

All of applicant's argument regarding the pending grounds of rejection have been fully considered but are not persuasive of error. It is noted that if the after-final amendment were enterable, the rejections under 35 U.S.C. § 112, second paragraph, could be withdrawn. It is also noted that if the

Art Unit: 1651

after-final amendment were enterable the § 102(b) rejections over Schneider, Yde, Isao (JP '377) and Miyakoshi (JP '591) could be withdrawn since none of those references explicitly discloses the use of lignosulfonate/lignosulfonic acid as the substrate.

However, Haars discloses not only the claimed lignosulfonate substrate, but also the same microorganism sources as applicant for the enzyme. Compare Haars at column 2, lines 27-37, to applicant's specification at pages 19-22. Thus, based on applicant's own disclosure of microorganisms which produce enzymes suitable for practicing the claimed invention, Haars appears to inherently disclose an enzyme having the claimed pH optimum, directly contrary to applicant's argument in this regard.

Lastly, and perhaps more importantly, applicant's argument regarding the § 103(a) rejection is not directly relevant, because the original rationale for that rejection would have to be reassessed in view of applicant's joining of two limitations which never appeared together during prosecution until now. That is, the proposed after-final amendment improperly results in the recitation of an embodiment whose limitations together have not searched or considered previously. Thus, the obviousness of the proposed new claims must be reassessed with

Art Unit: 1651

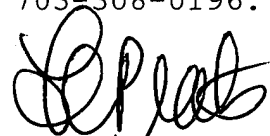
respect to the prior art. However, to the extent that applicant argues the incorrectness of the original rationale of a reasonable expectation of preparing peroxide *in situ* as recited in claim 16 by virtue of the presence of peroxidase in the composition, it is again pointed out that such processes are conventional in the art. See, e.g., Haars at column 3, lines 22-23, disclosing that " H_2O_2 also functions as an acceptor with peroxidase."

No claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Francisco C Prats whose telephone number is 703-308-3665. The examiner can normally be reached on Monday through Friday, with alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G Wityshyn can be reached on 703-308-4743. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9306 for regular communications and 703-872-9307 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.



Francisco C Prats
Primary Examiner
Art Unit 1651